

REMARKS

Claims 1, 4, 6-7, 9-16, 18-23, 25-27, 30-36, and 44-58 are pending. Claims 8, 17, 24, 28-29 and 43 are newly cancelled, without prejudice to further prosecution of the subject matter of the cancelled claims.

Reconsideration and withdrawal of all rejections is respectfully requested in view of the above-provided amendments and the following remarks.

AMENDMENTS TO THE CLAIMS

Claim 1 is amended to split the previously recited Markush group, by moving element (a) to new claim 46, and providing new dependent claims analogous to the claims depending from claim 1 before amendment. Claims 25, 26, 27, 30, 31 and 34 are amended to revise the respective claim dependencies, and to add dependencies from new claims 49 and 50, in order to more clearly and particularly set forth that which Applicants consider to be their invention. The initial capitalization of the word, "claim" is now removed throughout the pending claims, as suggested by the Examiner.

New claim 46 is copied from previous claim 1 and more particularly sets forth the invention of amended claim 1. New claim 47 is analogous to claim 6. New claim 48 is analogous to claim 9. New claims 49-50 are analogous to claim 19. New claim 51 and 55 are supported by the specification at page 4, lines 5-16. New claims 52-54 and 56-58 are analogous to previously pending claims, but depend from new claims 51 and 55, respectively.

No new matter is added.

THE CLAIM OBJECTIONS

At page 2 of the Office Action, the Examiner has objected to claims 25, 27, 30, 31 and 34 for allegedly being in improper dependent form. The Examiner takes the position that, "[a] claim cannot depend from a later claim."

Applicants respectfully traverse. 37 C.F.R. § 1.126 requires as follows.

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered

claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

Given the requirements of 37 C.F.R. § 1.126, Applicants entering new claims, may of necessity have a lower numbered claim depend from a higher numbered claim. This is typical of U.S. patent prosecution practice, and is addressed by the Examiner, pursuant to 37 C.F.R. § 1.126, after allowance. Thus, it is respectfully submitted that there is no proper basis for this ground of objection.

At page 3 of the Office Action, the Examiner has objected to claims 4, 6, 7-36 and 43-45 for the use of the word, "claim" with an initial capitalization.

Applicants respectfully disagree. The use of an initial capitalization for the word "claim" is a longstanding U.S. practice, and Applicants are aware of no law, rule or controlling authority preventing this practice. Nevertheless, in the interest of expeditious prosecution, and for consistency in the pending claims, all pending claims are now amended as requested by the Examiner.

For all of these reasons, reconsideration and withdrawal of the objections to the claims is respectfully requested.

THE CLAIMS ARE ENABLED UNDER 35 USC 112, FIRST PARAGRAPH

At page 4 of the Office Action, claims 34-36 and 44 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly not enabled for "protecting fish from IPN comprising administering said p45 antigen." In the Office Action from pages 5-6, the Examiner reasons, *inter alia*, that, "[w]hile the specification has provided for protection against SRS using the p45 antigen, the specification does not provide for protection from IPN using the p45 antigen alone as claimed."

Applicants respectfully disagree. Claim 34 is directed to,

[a] method of protecting a fish from salmonid rickettsial septicemia and Infectious Pancreatic Necrosis comprising administering to the fish the vaccine of claim 25.

Claim 25, in turn, is directed to

[t]he vaccine of any of claims 18-23, 45, 49 or 50 further comprising an antigen obtained from an Infectious Pancreatic Necrosis (IPN) virus.

Claims 18-23, 45, 49 and 50 are variously directed to vaccines comprising P^s p45 antigens or expression vectors. Thus, the methods recited by claims 34-36 and 44 employ a vaccine that includes a P^s p45 antigen (or an expression vector encoding the same) and that includes an IPN antigen.

The Examiner's attention is respectfully directed, for instance, to Examples 5 and 8 of the present application, wherein a combination vaccine of P^s p45 antigens and IPN antigens is prepared and shown to be effective in Atlantic salmon.

Thus, contrary to the Examiner's position, claims 34-36 and 44 do not require that the P^s p45 antigen immunize or protect against IPN virus. Instead, these claims are directed to a combination vaccine wherein P^s p45 protein or P^s p45 expression vector provides protection against salmonid rickettsial septicemia (SRS) and IPN antigen provides protection against IPN virus.

For all of the foregoing reasons, reconsideration and withdrawal of this ground of rejection is respectfully requested.

At page 6 of the Office Action, claims 28 and 29 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly not enabled. The Examiner has required a Deposit Declaration to confirm ongoing availability of the cells recited by these claims. Claims 28 and 29 are cancelled, without prejudice to further prosecution of the subject matter of these claims. Thus, this ground of rejection is obviated.

For all of the foregoing reasons, reconsideration and withdrawal of this ground of rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 101 IS OBIATED

At page 9 of the Office Action, the Examiner has rejected claims 8 and 43 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. Claims 8 and 43 are cancelled, without prejudice to further prosecution of the subject matter of these claims. Thus, this ground of rejection is obviated.

For all of the foregoing reasons, reconsideration and withdrawal of this ground of rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 102(b) IS OBIATED

At page 10 of the Office Action, the Examiner has rejected claims 8 and 43 under 35 U.S.C. § 102(b) as allegedly anticipated by New England Biolabs Catalog, 199611997 p 111 - Random primers. Claims 8 and 43 are cancelled, without prejudice to further prosecution of the subject matter of these claims. Thus, this ground of rejection is obviated.

For all of the foregoing reasons, reconsideration and withdrawal of this ground of rejection is respectfully requested.

CONCLUSION

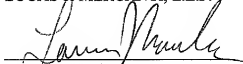
At page 10 of the Office Action, the Examiner notes that claim 1 is allowable. It is respectfully urged that amended claim 1 and new claim 46 remain allowable, and that the claims depending therefrom are also respectfully urged to be in condition for allowance, and early action to that end is respectfully requested.

This Amendment is believed to be timely submitted with an RCE Petition and a Petition for One-Month Extension of Time, with the required fees. However, in the event that it is determined that any additional Extension of Time is required, the Commissioner is authorized to treat this paper as the required petition for extension of time, and to charge any required fee to Deposit Account No. 02-2275.

The claims pending with the filing of the previous response, dated April 7, 2008 totaled 71 claims, with 1 independent claim. After entry of the present amendment, there will be a total of 60 claims, with two independent claims. Thus, it is not believed that any additional claim fee is due for entry of the present amendment. Nevertheless, if any other fee is determined to be required for entry of this paper, that fee may also be charged to the above-mentioned Deposit Account.

Respectfully submitted,

LUCAS & MERCANTI, L.L.P.


Laurence Manber

Reg. No. 35,597

LUCAS & MERCANTI, L.L.P.
475 Park Avenue South
New York, New York 10016
Phone: 212-661-8000
Fax: 212-661-8002